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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHEL CHORNET and ESTABAN CHORNET

Appeal 2015-004270
Application 13/066,605
Technology Center 1700

Before TERRY J. OWENS, WESLEY B. DERRICK, and DEBRA L. DENNETT, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 11–20. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim a treated heavy crude oil. Claim 11 is illustrative:

> 11. A treated heavy crude oil, wherein said heavy crude oil has been treated ex situ, which has a viscosity at 15°C which is less than the viscosity of said heavy crude oil at 15°C prior to the treatment thereof, and wherein the temperature at which 80 mass % of the treated heavy crude oil boils is within 25°C of the temperature at which 80 mass % of the heavy crude oil prior to the treatment thereof has boiled, wherein said heavy crude

oil, prior to the treatment thereof, has an API gravity that does not exceed 22.3°.

The Reference

Khan	US 2004/0035749 A1	Feb. 26, 2004

The Rejections

Claims 11–20 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 over Khan.

OPINION

We affirm the rejections.

The Appellants argue the claims as a group (App. Br. 2–4). We therefore limit our discussion to one claim, i.e., claim 11, which is the sole independent claim. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2012).

The Appellants' claim 11 requires a heavy crude oil having an API gravity of 22.3º or less which has been treated to reduce its viscosity at 15 ºC relative to the viscosity of the untreated heavy crude oil at 15 ºC. That viscosity reduction can be achieved by mixing the heavy crude oil with an organic material such as pentane, liquefied petroleum gases, alcohols, ethers and mixtures thereof in an amount such as about 5 to about 25 vol% of the initial heavy crude oil (Spec. 9–10). Claim 11 also requires that the temperature at which 80 mass % of the treated heavy crude oil boils is within 25 ºC of the temperature at which 80 mass % of the initial heavy crude oil boils. As indicated by a comparison of the distillation data in the Appellants' Tables 2 and 3, due to the presence of the organic material which boils at a lower temperature than the initial heavy crude oil, the treated heavy crude oil has an initial boiling point and boiling points at low mass % recovered which are lower than those of the initial heavy crude oil.

However, as the distillation removes increasing amounts of the lower-boiling organic material relative to the heavy crude oil, the boiling points of the treated heavy crude oil gradually approach those of the initial heavy crude oil, and at 81 mass % recovered the boiling points of the treated and initial heavy crude oil are, respectively, 717.6 ºC and 717.2 ºC.

Khan reduces the viscosity of crude petroleum having an API gravity of about 6 to 12 by mixing into it a viscosity reducing additive such as gasoline, naphtha, butanol, petroleum ether, diesel fuel and mixtures thereof, in an amount of about 15 to about 50 wt%, before or after the crude petroleum is sheared using a rotor-stator mechanism at about 500 to about 25,000 rpm (¶¶ 8, 15–20, 26, 28).

The Appellants assert, regarding the Examiner's Answer's attachment's Figures 1 and 2, wherein Figure 1 shows boiling point distribution for Hamaca crude (tested by Khan (Table 1)) with and without being mixed with 15 wt% and 20 wt% gasoline, and Figure 2 shows kinematic viscosity versus temperature for Hamaca crude with and without being mixed with 20 wt% gasoline, that "[t]he Examiner's presentation of Figures 1 and 2 provides no information that the treated heavy oils of Khan inherently would have a viscosity at 15ºC that is lower than the viscosity at 15ºC prior to the treatment of such oils" (Reply Br. 1–2).

The Appellants provide no evidence, or even argument, that adding gasoline or any of Khan's other viscosity reducing additives to Khan's crude petroleum would not reduce the crude petroleum's viscosity at 15 ºC. The Examiner's Figure 2 shows that mixing gasoline with Hamaca crude reduces the crude's viscosity over a range of temperatures above 15 ºC, thereby indicating that it also reduces the crude's viscosity at 15 ºC. Moreover, the

Appellants' disclosed alcohol used to reduce the heavy crude oil's viscosity (Spec. ¶ 9) includes Khan's butanol (¶¶ 17, 26).

Hence, there is sound basis for believing that Khan's treated crude oil has the reduced viscosity at 15 ºC required by the Appellants' claim 11. The Appellants, therefore, have the burden of providing a showing to the contrary. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) ("[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."). *See also In re Best*, 562 F.2d 1252, 1255 (CCPA 1977):

> Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. [citation omitted] Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products.

The Appellants have not carried that burden.

Thus, we are not persuaded of reversible error in the rejections.

DECISION/ORDER

The rejections of claims 11–20 under 35 U.S.C. §§ 102(b) and 103 over Khan are affirmed.

It is ordered that the Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED